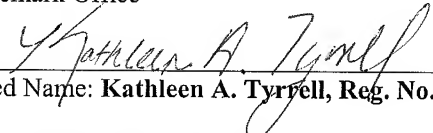


IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No.: PENN0870US.NP  
Inventors: Sweeney et al.  
Serial No.: 10/566,796  
Filing Date: Not yet assigned  
Examiner: Not yet assigned  
Customer No.: 26259  
Group Art Unit: Not yet assigned  
Confirmation No.: 8993  
Title: Bowman-Birk Inhibitor Compositions for  
Treatment of Muscular Atrophy and  
Degenerative Muscle Disease

Electronically Submitted via EFS-Web  
Date: October 9, 2007

I hereby certify that this paper is being electronically  
submitted on the date indicated above to the  
Commissioner for Patents, U.S. Patent &  
Trademark Office

By   
Typed Name: Kathleen A. Tyrrell, Reg. No. 38,350

**BOX MISSING PARTS**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**RESPONSE TO DECISION**

In response to the "DECISION" dated **September 28, 2007**, a  
response to which is due **October 28, 2007**, enclosed herewith are

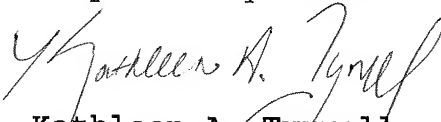
three separately executed Declaration and Power of Attorney Forms  
by the inventors which comply with 37 C.F.R. 1.63.

(XX) Copy of Decision.

( ) Other:

(XX) Please charge any deficiency or credit any overpayment  
to Deposit Account No. 50-1619.

Respectfully submitted,

  
**Kathleen A. Tyrrell**  
Registration No. 38,350

Date: October 9, 2007

Licata & Tyrrell P.C.  
66 E. Main Street  
Marlton, New Jersey 08053

(856) 810-1515

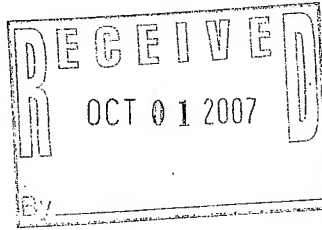
28 SEP 2007



United States Patent and Trademark Office

10/28/07

LICATA & TYRRELL P.C.  
66 E. MAIN STREET  
MARLTON NJ 08053



Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
www.uspto.gov

In re Application of  
Sweeney et al.  
Application No.: 10/566,796  
PCT No.: PCT/US04/24718  
Int. Filing Date: 30 July 2004  
Priority Date: 01 August 2003  
Attorney Docket No.: PENN0870US.NP  
For: Bowman-Birk Inhibitor Compositions For Treatment :  
Of Muscular Atrophy And Degenerative Muscle Disease :

DECISION

This is in response to the correspondence filed on 09 November 2006.

Docket System ☒  
Status Report ☒  
Docket Book ☒

### BACKGROUND

This international application was filed on 30 July 2004, claimed an earlier priority date of 01 August 2003, and designated the U.S. The 30 month time period for paying the basic national fee in the United States expired at midnight on 01 February 2006. Applicants filed *inter alia* the basic national fee on 31 January 2006.

On 09 June 2006, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicants, requiring the submission of an oath or declaration compliant with 37 CFR 1.497(a) and (b), an initial paper of compact disc copy of a sequence listing, an amendment directing its entry, and a copy of the sequence in computer readable form ("CRF").

### DISCUSSION

Counsel states that she has

carefully reviewed the application and respectfully disagrees that a Sequence Listing is required. There are no nucleotide and/or amino acid sequences disclosed in the instant application which require submission of a Sequence Listing. Reconsideration of this requirement is therefore respectfully requested.

Based on counsel's remarks, the requirements included in the Form PCT/DO/EO/905 mailed on 09 June 2005 pertaining to a sequence listing are hereby **WITHDRAWN**.

Applicants also submitted a declaration of inventorship on 09 November 2006. Inspection of this declaration reveals that it appears to have been assembled by adding a second page 3 of 4 to the document. Applicants' attention is drawn to MPEP 201.03, which explains in part that

An oath or declaration under 37 CFR 1.63 by each actual inventor must be presented. While each inventor need not execute the same oath or declaration, each oath or declaration executed by an inventor must contain a complete listing of all inventors so as to clearly indicate what each inventor believes to be the

appropriate inventive entity. Where individual declarations are executed, they must be submitted as individual declarations rather than combined into one declaration. For example, where the inventive entity is A and B, a declaration may not be executed only by A naming only A as the inventor and a different declaration may not be executed only by B naming only B as the inventor, which two declarations are then combined into one declaration with a first page of boiler plate, a second page with A's signature, and a second page with B's signature (so that it appears that the declaration was executed with the entire inventive entity appearing in the declaration when it did not).

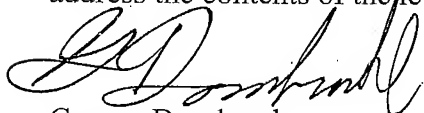
In view of this policy, it would not be appropriate to accept the declaration document filed on 09 November 2006 for purposes of compliance with 37 CFR 1.497(a) and (b). The declaration is also defective in view of the un-initialed alterations to the page signed by Mr. Morris.

### DECISION

The declaration is **NOT ACCEPTED**, without prejudice.

If reconsideration on the merits of this matter is desired, a proper response must be filed within **ONE (1) MONTH** from the mail date of this decision. Extensions of time may **NOT** be obtained under 37 CFR 1.136(a). Failure to timely file a proper response (specifically, an acceptable oath or declaration) will result in **ABANDONMENT**.

Please direct any further correspondence with respect to this matter to the Assistant Commissioner for Patents, Mail Stop PCT, P.O. Box 1450, Alexandria, VA 22313-1450, and address the contents of the letter to the attention of the Office of PCT Legal Administration.



George Dombroske  
PCT Legal Examiner  
Office of PCT Legal Administration  
Tel: (571) 272-3283  
Fax: (571) 273-0459

Docket No.  
PENN0870US.NP

## Declaration and Power of Attorney For Patent Application

### English Language Declaration

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name,

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled

**Bowman-Birk Inhibitor Compositions for Treatment of Muscular Atrophy and Degenerative Muscle Disease**

the specification of which

(check one)

☐ is attached hereto.

☒ was filed on July 30, 2004 as United States Application No. or PCT International Application Number PCT/US2004/024718 and was amended on \_\_\_\_\_

(if applicable)

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR 1.56, including for continuation-in-part applications, material information which became available between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

I hereby claim foreign priority benefits under 35 U.S.C. 119(a)-(d) or (f), or 365(b) of any foreign application(s) for patent, or plant breeder's rights certificate(s), or 365(a) of any PCT International application which designated at least one country other than the United States of America, listed below and have also identified below, by checking the box, any foreign application for patent, inventor's or plant breeder's rights certificate(s), or any PCT international application having a filing date before that of the application on which priority is claimed.

Prior Foreign Application(s)

Priority Claimed

<u>(Number)</u>	<u>(Country)</u>	<u>(Day/Month/Year Filed)</u>	<input type="checkbox"/>
<u>(Number)</u>	<u>(Country)</u>	<u>(Day/Month/Year Filed)</u>	<input type="checkbox"/>
<u>(Number)</u>	<u>(Country)</u>	<u>(Day/Month/Year Filed)</u>	<input type="checkbox"/>

I hereby claim the benefit under 35 U.S.C. Section 119(e) of any United States provisional application(s) listed below:

<u>60/491,695</u>	<u>August 1, 2003</u>
(Application Serial No.)	(Filing Date)

(Application Serial No.) (Filing Date)

\_\_\_\_\_  
(Application Serial No.) (Filing Date)

I hereby claim the benefit under 35 U. S. C. Section 120 of any United States application(s), or Section 365(c) of any PCT International application designating the United States, listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States or PCT International application in the manner provided by the first paragraph of 35 U.S.C. Section 112, I acknowledge the duty to disclose to the United States Patent and Trademark Office all information known to me to be material to patentability as defined in Title 37, C. F. R., Section 1.56 which became available between the filing date of the prior application and the national or PCT International filing date of this application:

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[illegible][illegible]

(Application Serial No.)	(Filing Date)	(Status) (patented, pending, abandoned)
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(Application Serial No.)	(Filing Date)	(Status) (patented, pending, abandoned)
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I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

POWER OF ATTORNEY: As a named inventor, I hereby appoint the following attorney(s) and/or agent(s) to prosecute this application and transact all business in the Patent and Trademark Office connected therewith. *(list name and registration number)*

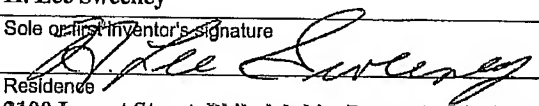
CUSTOMER NUMBER: 26259

Send Correspondence to:

Licata & Tyrrell P.C.  
66 E. Main Street  
Marlton, New Jersey 08053

Direct Telephone Calls to: *(name and telephone number)*

Kathleen A. Tyrrell - (856) 810-1515

Full name of sole or first inventor	
H. Lee Sweeney	
Sole or first inventor's signature	
Residence	Date 10/3/07
2100 Locust Street, Philadelphia, Pennsylvania 19103	
Citizenship	
US	
Post Office Address	
Same as above	

Full name of second inventor, if any	
Carl A. Morris	
Second inventor's signature	Date
Residence	
25 Elm Avenue, Quincy, Massachusetts 02170	
Citizenship	
Australian	
Post Office Address	
Same as above	

Full name of third inventor, if any <b>Ann R. Kennedy</b>	
Third inventor's signature	Date
Residence <b>1010 Indian Creek Lane, Wynnewood, Pennsylvania 19151</b>	
Citizenship <b>US</b>	
Post Office Address <b>Same as above</b>	

Full name of fourth inventor, if any	
Fourth inventor's signature	Date
Residence	
Citizenship	
Post Office Address	

Full name of fifth inventor, if any	
Fifth inventor's signature	Date
Residence	
Citizenship	
Post Office Address	

Full name of sixth inventor, if any	
Sixth inventor's signature	Date
Residence	
Citizenship	
Post Office Address	



Docket No.  
PENN0870US.NP

## Declaration and Power of Attorney For Patent Application

### English Language Declaration

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**Bowman-Birk Inhibitor Compositions for Treatment of Muscular Atrophy and Degenerative Muscle Disease**

the specification of which

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Priority Claimed

(Number) _____	(Country) _____	(Day/Month/Year Filed) _____	<input type="checkbox"/>
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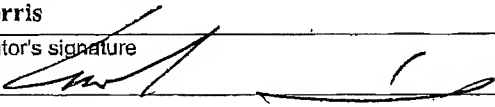
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Direct Telephone Calls to: *(name and telephone number)*

Kathleen A. Tyrrell - (856) 810-1515

Full name of sole or first inventor <b>H. Lee Sweeney</b>	Date
Sole or first inventor's signature	
Residence <b>2100 Locust Street, Philadelphia, Pennsylvania 19103</b>	
Citizenship <b>US</b>	
Post Office Address <b>Same as above</b>	

Full name of second inventor, if any <b>Carl A. Morris</b>	Date
Second inventor's signature 	<b>10/2/07</b>
Residence <b>25 Elm Avenue, Quincy, Massachusetts 02170</b>	
Citizenship <b>Australian</b>	
Post Office Address <b>Same as above</b>	

Full name of third inventor, if any <b>Ann R. Kennedy</b>	
Third inventor's signature	Date
Residence <b>1010 Indian Creek Lane, Wynnewood, Pennsylvania 19151</b>	
Citizenship <b>US</b>	
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Fifth inventor's signature	Date
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Post Office Address	

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Sixth inventor's signature	Date
Residence	
Citizenship	
Post Office Address	

Docket No.  
PENN0870US.NP

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August 1, 2003

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Full name of sole or first inventor <b>H. Lee Sweeney</b>	
Sole or first inventor's signature	Date
Residence <b>2100 Locust Street, Philadelphia, Pennsylvania 19103</b>	
Citizenship <b>US</b>	
Post Office Address <b>Same as above</b>	

Full name of second inventor, if any <b>Carl A. Morris</b>	
Second inventor's signature	Date
Residence <b>25 Elm Avenue, Quincy, Massachusetts 02170</b>	
Citizenship <b>Australian</b>	
Post Office Address <b>Same as above</b>	

Full name of third inventor, if any <b>Ann R. Kennedy</b>	<i>October 2, 2007</i>
Third inventor's signature <i>Ann Randee Kennedy</i>	Date
Residence <b>1010 Indian Creek Lane, Wynnewood, Pennsylvania 19151-19096</b>	
Citizenship <b>US</b>	
Post Office Address <b>Same as above</b>	

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Fourth inventor's signature	Date
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Full name of fifth inventor, if any	
Fifth inventor's signature	Date
Residence	
Citizenship	
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Full name of sixth inventor, if any	
Sixth inventor's signature	Date
Residence	
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